

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q60742

Nicolas BROGNE, et al.

Appln. No.: 09/667,779

Group Art Unit: 2151

Confirmation No.: 1269

Examiner: Khanh Q. DINH

Filed: September 22, 2000

For: A METHOD OF MANIPULATING AN ALREADY SENT E-MAIL AND
CORRESPONDING SERVER

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is Alcatel, the assignee of the application.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-12 are all of the claims pending in the application.

Claims 1, 2, 11 and 12 are rejected under 35 USC 102(e) as anticipated by Nielsen (USP 5,870,548).

Claims 3-10 are rejected under 35 USC 103(a) as unpatentable over Nielsen in view of Uchida (USP 6,327,610).

IV. STATUS OF AMENDMENTS

An amendment was filed on May 23, 2006. The amendment was refused entry by the Advisory Action mailed June 20, 2006. Accordingly, the claims on appeal, and as set forth in the Appendix hereto, do not include the changes proposed by the amendment filed May 23, 2006.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The problem to which the present invention is directed is how to allow a sender of an email to retract or modify the email. One option known in the art and acknowledged in the paragraph bridging pages 1-2 of the specification is to have the sender send a cancel or modify message to the receiver where the original email can be deleted or modified, but this is disadvantageous in that the recipient is notified of the deletion or modification. Another option known in the prior art and acknowledge at page 2 of the specification is to retain the actual email at the sender email system where it remains under close control of the sending system, but such a system is cumbersome.

The present invention provides a method of manipulating an already sent e-mail addressed by a sender to an addressee, so that the sender can retract or modify the already sent e-mail as long as the addressee of the e-mail has not accessed it. With reference to Fig. 1, the sending computer 10 sends emails via network 13 to receiving computers 11 and 12. At least the email body of the emails are stored in a server 14 which is operated independently of the email systems at each of the addressees 11 and 12. When the sender wishes to cancel or modify a sent message, a modification message is sent to the server 14 which then modifies the previously sent email if the email body stored on the server 14 has not yet been accessed by any of the addressees. If any of the addressees has already accessed the email, the modification of the email on the server 14 is denied.

It is unnecessary to describe further details of the system or method of the present invention, since all features relied on for patentability are described in the above summary.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are:

1. Whether claims 1, 2, 11 and 12 are anticipated by Nielsen; and
2. Whether claims 3-10 are unpatentable over Nielsen in view of Uchida.

VII. ARGUMENT

Claims 1, 2, 11 And 12 Are Not Anticipated By Nielsen.

As shown in Fig. 2 of Nielsen, that reference is dealing with an arrangement wherein an email message is sent from a sender email system 200 to a receiver email system 202. As described at lines 30-43 of column 6, a message sent by the sender is sent over the internet and stored in the receiver email system where it is processed and is no longer under the control of the sender. At columns 6-11, Nielsen then describes various details about the forming of a modify or cancel message by the sender, and at lines 17-20 of column 10 and lines 12-15 of column 11 point out that the cancel or modify messages are then sent to the recipient email system using the same prior art methods as used for sending the original email.

Beginning at line 16 of column 11, Nielsen then describes what happens at the receiving email system. A first point to note is that this is the receiving email system. It is not “a server that operates independently from any e-mail processing means associated with each of said addressees and on which at least the body of said sent e-mail is stored” as is required of claim 1 of the present application. This is a conventional system where the emails sent by the sender are received by and stored at the receiving email system. For this reason alone, there cannot possibly be any anticipation of the present claims by Nielsen.

Returning back to the cited passage beginning at column 14, the discussion actually begins at line 16 of column 14 and relates to how a cancel message is processed by the receiving email system. Beginning at line 65 of column 14, Nielsen describes that if the email has already been seen by the recipient, the recipient is given a number of choices as to what to do with the

previously sent email. The two choices are (1) deleting the original email or (2) treating the cancel message as a normal message. If the recipient elects to delete the original email, the email is deleted from the recipient's email system.

Claim 1 specifies that modification of the email body is denied to all addressees if at least one addressee has accessed the email message. This is directly contrary to what Nielsen teaches, and there can be no anticipation of claim 1.

Independent claim 11 recites this same feature not taught in the art.

In his remarks in the first three lines of page 4 of the final Office action, seemingly in support of his anticipation argument, the examiner points out that a previously sent message can be deleted even if an addressee has accessed the email. This appears to be a concession on the part of the examiner that the primary reference relied on does not teach this central feature of the claimed invention. Yet the examiner persists in the rejection.

Beginning at line 26 of column 16, Nielsen describes what happens when the sender attempts to modify an email that has already been seen by the recipient. As is clearly described there, the sender is in fact permitted to modify the email, and the recipient is notified. This is what is described as prior art in the Background section of the present application and is exactly contrary to what is claimed in the present case.

At page 14 of the final Office action, the examiner speaks on this issue by pointing out that Nielsen allows deletion of previously sent messages if the recipient has seen the message, therefore there is modification by users/senders. But the claim is about what is not permitted. The claimed invention is about not permitting modification of an email body that has been

accessed by the recipient. Nielsen does permit modification by the sender even after the email has been read, and also permits the addressee to delete, so Nielsen does not anticipate claim 1. Nielsen is nothing more than the conventional email system discussed in the paragraph bridging pages 1-2 of the present application.

As is clear from the above, Nielsen does not teach or suggest what is presently claimed, and is in fact directly contrary. The secondary references do not make up for the deficiency in Nielsen. All of the independent claims contain the same distinguishing feature as claim 1. Accordingly, all claims are believed in condition for allowance.

Claims 3-10 Are Not Unpatentable Over Nielsen in View of Uchida.

Uchida is relied on by the examiner to teach the access code recited in claim 3. Uchida is not relied on to teach, nor does it teach, the denial of modification of an email if any addressee has accessed the email. Thus, there is nothing in either reference to teach the denial of modification rights to all addressees if any addressee has accessed the email, particularly since Nielsen explicitly permits an addressee to delete the email after it has been accessed, even after a cancel message is sent by the sender.

CONCLUSION

Beginning at line 65 of column 14, Nielsen describes that if a sender of a previous email sends a cancel message and the original email has already been seen by the recipient, the recipient is given a number of choices as to what to do with the previously sent email. The two choices are (1) *deleting the original email* or (2) treating the cancel message as a normal message. If the recipient elects to delete the original email, the email is deleted from the

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recipient's email system. This is directly contrary to what is recited in claim 1, which states that modification of the email body is denied to all addressees if at least one addressee has accessed the email body. Thus, there cannot possibly be anticipation of any of the claims, all of which require that modification be denied if any addressee has accessed the email. The secondary reference relied on is not even suggested by the examiner to teach this feature. Thus, all claims patentably distinguish over the prior art.

Respectfully submitted,

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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: October 30, 2006

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CLAIMS APPENDIX

CLAIMS 1, 2, 11 and 12 ON APPEAL:

1. A method of manipulating a sent e-mail addressed by a sender to a plurality of addressees, said sent e-mail comprising an address header and a body, wherein said method comprises:

routing a modification message over a data network to a server that operates independently from any e-mail processing means associated with each of said addressees and on which at least the body of said sent e-mail is stored, said modification message being sent by said sender and for modifying said e-mail body; and

modifying said e-mail body at said server according to said modification message if said e-mail body has not been accessed on said server by any of said addressees, wherein the modification of said e-mail body is denied to all addressees if at least one addressee has accessed said e-mail body on said server, and wherein the modification of said e-mail body occurs at said server independently of any e-mail processing means associated with each of said addressees.

2. A method according to claim 1, wherein said modification of said e-mail comprises deleting said e-mail body or modifying a part of said e-mail body, said sender being informed by said server if said modification has been executed or not.

3. A server able to receive, from a data network, an e-mail comprising an address header and a body and addressed by a sender to a plurality of addressees, wherein said server operates independently from any e-mail processing means associated with each of said addressees, said server comprising:

means for storing at least the body of said received e-mail together with an access code on said server;

means for sending to each addressee a notification message of said e-mail, said notification message containing the access code for accessing said e-mail body;

means for handling a status storage indicating at least whether said e-mail body has been accessed by one of said addressees;

means for receiving a modification message for modifying said e-mail body; and

means for modifying said e-mail body according to said modification message, if said e-mail body has not been accessed on said server by any of said addressees, wherein the modification of said e-mail body is denied to all addressees if at least one addressee has accessed said e-mail body on said server, and wherein the modification of said e-mail body occurs at said server independently of any *e-mail* processing means associated with each of said addressees.

4. A server according to claim 3, further comprising means for sending a message to the sender of said modification message to notify the sender if the modification has been executed or not.

5. A server according to claim 3, further comprising means for sending a message to the sender of said e-mail containing said access code associated to said e-mail.

6. A server according to claim 3, further comprising:
means for downloading said e-mail body to one of said addressee providing said access code; and

means for deleting said e-mail body at said server when each one of said addressees has accessed said e-mail body at said server.

7. A server according to claim 3, further comprising:
means for storing the header of said e-mail; and
means for executing an authentication procedure when a user tries to access said e-mail body by providing said access code.

8. A server according to claim 3, further comprising:
means for storing the header of said e-mail;
means for receiving a modification message for modifying said e-mail header only or said e-mail body; and
means for modifying said e-mail header according to said modification message, if said e-mail has not been accessed by any of said addressees.

9. A server according to claim 3, further comprising:
means for storing the header of said e-mail;
means for sending to said addressees an e-mail containing said e-mail header and said e-mail body after a predefined time period; and
deleting from said server said e-mail header and said e-mail body.

10. A computer program product to be executed on a server according to claim 3, said computer program product comprising computer program code means embodied on a computer-readable medium and adapted to perform a method of modifying an e-mail comprising an address header and a body and sent to a plurality of addressees, wherein said method comprises:
storing the body of a received e-mail together with an access code on said server;
sending to each addressee of said e-mail a notification containing the access code for accessing said e-mail body;
handling a status storage indicating at least whether said e-mail body has been accessed by one of said addressees; and
if a modification message for modifying said e-mail body is received, modifying said e-mail body according to said modification message, if said e-mail body has not been accessed on said server by any of said addressees, wherein the modification of said e-mail body is denied to all addressees if at least one addressee has accessed said e-mail body on said server, and wherein the modification of said e-mail body occurs at said server independently of any e-mail processing means associated with each of said addressees.

11. A computer program product to be executed on a computer and comprising computer program code means embodied on a computer-readable medium, said computer program code means adapted to perform:

composing a modification message for modifying an e-mail addressed to a plurality of addressees and sent to a predefined server, said predefined server operating independently from any e-mail processing means associated with each of said addressees; and

sending said modification message to said server to modify at least the body of the e-mail sent to and stored on said predefined server if the e-mail body has not been accessed on said server by any of said addressees, wherein the modification of said e-mail body is denied to all addressees if at least one addressee has accessed said e-mail body on said server, and wherein the modification of said e-mail body occurs at said predefined server independently of any e-mail processing means associated with each of said addressees.

12. A personal computer equipped with a computer program according to claim 11.

EVIDENCE APPENDIX:

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

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Submitted herewith please find an Appeal Brief.

Respectfully submitted,

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